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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,425	10/05/2001	Kenneth C. Cundy	033053-025	5701

21839 7590 09/29/2003

BURNS DOANE SWECKER & MATHIS L L P  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER

BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/29/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/972,425

Applicant(s)

CUNDY ET AL.

Examiner

Barbara P. Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) 1,3,4,18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 5-10 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Status of the Application***

2. Claims 1, 3-10 and 18-20 are pending in the present application. Claims 5-10 and 19 were examined to the extent they read on the generic group identified in the previous Office Action. Claims 1, 3, 4, 18 and 20 stand withdrawn from further consideration as being drawn to a nonelected invention. It was noted in the previous Office that upon allowance of compound claims, method claims of the same scope as the allowed compounds would be allowable.

### ***Election/Restrictions***

3. Applicant's traversal of the restriction in Paper No. 11 is acknowledged. The traversal is on the ground(s) that it is improper for the Office to refuse to examine that which Applicants regard as their invention unless the subject matter of the claims lacks unity of invention. Accordingly, Applicant states that the claims as presently amended have unity of invention. Applicant also reminds the Examiner that even where a provisional election of a single species is proper prior to examination on the merits, following election, the Markush-type claim should be examined fully with respect to the elected species and further to the extent necessary to determine patentability according

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to MPEP § 803.02. This is not found persuasive because restriction may be require if two or more patentably distinct inventions are claimed in one application (see MPEP § 803). The instant claims encompass several patentably distinct inventions. For example, the definition of the variables according to the elected species are (i) X, R<sup>1</sup> and R<sup>2</sup> are each a hydroxyl group and (ii) Z is -M-Q<sup>b</sup>-D' wherein M is -CH<sub>2</sub>CH<sub>2</sub>C(O)-; Q<sup>b</sup> is a linking group of formula -[E-(F\*)<sub>n</sub>-G]<sub>m</sub> wherein m is 1, E is oxygen, F\* is -CH<sub>2</sub>- (i.e., n=1) and G is -C(O)- and D' is NHCH<sub>2</sub>C(-CH<sub>2</sub>)<sub>5</sub>CH<sub>2</sub>CO<sub>2</sub>H. However, the claimed invention encompasses compounds such as compound 45 wherein (i) X, R<sup>1</sup> and R<sup>2</sup> are each a hydroxyl group and (ii) Z is -M-Q<sup>b</sup>-D' wherein M is -CH<sub>2</sub>OC(O)-; Q<sup>b</sup> is a covalent bond and D' is NHCH<sub>2</sub>C(-CH<sub>2</sub>)<sub>5</sub>CH<sub>2</sub>CO<sub>2</sub>H. Compounds 45 and the elected species are patentably distinct and, thus, restriction between the two compounds would be proper.

The requirement is still deemed proper and is therefore made **FINAL**.

### ***Claim Rejections - 35 USC § 112***

4. The rejection of claims 5 and 19 under 35 USC 112, second paragraph is **withdrawn**.

### ***Allowable Subject Matter***

5. Claims 5-10 and 19 are objected to as containing nonelected inventions, but would be allowable to the extent they read on the generic group defined in Paper No.

10. As stated in the previous Office Action, method claims of the same scope as compounds of the generic group defined in Paper No. 10 would also be allowable.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***Telephone Inquiry***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

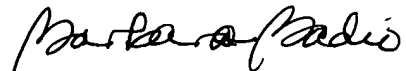
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308- 2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

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A handwritten signature in black ink, appearing to read "Barbara P. Badio". The signature is fluid and cursive, with the first name "Barbara" and last name "Badio" clearly distinguishable.

Barbara P. Badio, Ph.D.

Primary Examiner

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BB

September 25, 2003